

REMARKS/ARGUMENTS

Responsive to the Office Action mailed August 18, 2005:

I. NON-PRIOR ART MATTERS

A. The Office Action objected to the claims.

The second claim 38 has been renumbered to claim 41.

II. PRIOR ART MATTERS

A. The Office Action rejected claims 33-36, 37, 38, and 40 under 35 USC 102(b) as being anticipated by Katoch. Applicant respectfully traverses this rejection.

A single prior art reference anticipates a claimed invention only if it discloses each and every claim element.¹

As to amended claim 33, Katoch does not disclose: receiving an item in a first end of an item receiving mechanism; moving a second end of the item receiving mechanism to track the motion of a stacking mechanism.

The conveyor 13 does not have a second end that moves to track the motion of the stacking mechanism 20. Rather, the speed of the conveyors 17 is set to be faster than that of the conveyor belts 15.

Claims 34-36 contain additional elements or limitations beyond allowable claim 33 and are also allowable.

Further as to claim 34, the Office Action has not shown where Katoch discloses the claimed limitations.

Further as to claim 35, the Office Action has not shown where Katoch discloses the claimed limitations.

As to amended claim 37, Katoch does not disclose: wherein the conveyor's depositing end moves substantially vertically to track the motion of the recycling stacker shelves.

¹ *Structural Rubber Prod. Co. v. Park Rubber Co.*, 749 F.2d 707, 223 USPQ 1264 (Fed. Cir. 1984)

Claims 38-40 contain additional elements or limitations beyond allowable claim 37 and are also allowable.

B. The Office Action rejected claim 39 under 35 USC 103(a) as being unpatentable over Katoch in view of Dimion. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.² If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.³

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.⁴

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

The reference does not teach or suggest all the claim limitations.

Claim 39 contains additional elements or limitations beyond allowable claim 37 and is also allowable.

Further as to claim 39, Applicant disagrees that the cited lines of Dimion disclose a jam clearance mechanism. The cited lines only disclose that the first transfer 22 may need to be reversed or slowed down in the event of a jam or potential jam, without disclosing a mechanism for clearing such a jam.

²MPEP Sec. 2142.

³ Id.

⁴Id. (emphasis supplied)

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

Respectfully submitted,

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By: Nelson Capes
Gerald E. Helget (Reg. No. 30,948)
Nelson R. Capes (Reg. No. 37,106)
BRIGGS AND MORGAN, P.A.
2200 IDS Center
80 South Eighth Street
Minneapolis, MN 55402
Telephone: (612) 977-8480